

REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the following comments.

Discussion of Rejection of Claims 1-5, 8, 14-16, 19-22, and 23-40 Under 35 U.S.C. § 103(a)

In an Office Action, Claims 1-5, 8, 14-16, 19-22, and 23-40 were rejected were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,167,567, to Chiles, et al. (hereinafter "Chiles") in view of U.S. Patent No. 6,080,207, to Kroening, et al (hereinafter "Kroening"). For the reasons set forth below, Applicant respectfully disagrees with the Examiner's rejections.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicant respectfully submits that the cited prior art fails to teach or suggest all of the claim limitations from the above-listed claims. Furthermore, Applicant respectfully submits that there is no motivation to modify the prior art as suggested by the Examiner.

Claim 1, 14, 19, 22, 25, and 33

One embodiment of the claimed invention is directed to performing maintenance and diagnostic actions. In particular, Claim 1 recites "performing an initial action with respect to the electronic device responsive to receiving the activated hypertext link; and wherein the initial action is one of downloading a device driver identified with a hardware component of the electronic device, generating a disk image, or installing a service pack." Independent Claims 14, 19, and 22, each recite similar limitations. As discussed below, Applicant submits that the cited references do not teach or suggest, at least, these limitations.

Chiles is generally directed to a technique for automatically updating software on a client computer in a networked client-server computer. In Chiles, each software package registers itself during the installation on the computer. *See* col. 4, lines 7-15. As part of registration, a network uniform resource locator (URL) is provided of an FTP at which an update script for that is associated with the software package. *See* col. 4, lines 13-15. At a user-scheduled time, the

client-update software on the computer establishes a network connection to the FTP site and downloads the corresponding script. *See* col. 4, lines 32-42. At the computer, the downloaded script is executed and/or control is passed to a website. *See* col. 4, lines 43-65.

Applicant respectfully submits that Chiles fails to teach or suggest the limitation from Claim 1: "presenting via the electronic device a graphical representation of a text markup language document wherein the graphical representation includes at least one interactive control for activating a hypertext link." Similar limitations are recited in independent Claims 14, 19, and 22. In the Office Action, the Examiner took the position that these limitations were described on col. 3, line 57 – col. 4, line 15 of Chiles. Applicant has reviewed the cited section and submits that the cited section fails to describe this limitation. The cited section merely describes the auto-update procedure described above but fails to describe a graphical representation of a text markup language document wherein the graphical representation includes at least one interactive control for activating a hypertext link. Applicant notes that although the client update software of Chiles provides certain graphical user interfaces, e.g., Figures 14A-14D, there is no teaching or suggestion that these GUI are graphical representations of a text markup language.

Furthermore, Applicant respectfully submits that there is no motivation or suggestion to combine Chiles with Kroening as suggested by the Examiner. In the Office Action, the Examiner took the position that "It would have been obvious at the time of the invention that a person with ordinary skill in the art would want to create the disk image of Kroening in the updating software interface of Chiles for an easy to monitor software configuration process." Applicant respectfully submits that this finding fails to support a valid reason for modification of the cited references to derive the claimed invention. Applicant respectfully submits that the Examiner has failed to explain how creating a disk image would (1) facilitate monitoring the software configuration process or (2) why additional monitoring of the software configuration in Chiles is needed. Applicant notes that in one embodiment of the claimed invention, the reason for creating a disk image is different than the reason for creating a disk image in Kroening. In Kroening, the creation of disk image is used so as to help the mass production of computer systems having particular software. In one embodiment of the claimed invention, the reason for creating a disk image is that a user has a problem on his or her computer and the disk image is used by a technician so as to diagnose a problem. Applicant notes that neither the systems of Chiles or Kroening are used for computer diagnostic functions.

Applicant submits that the prior art must suggest the desirability of the claimed invention. *See* M.P.E.P. § 2143.01. The fact that references can be modified is not sufficient to establish prima facie obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness. *Id.* In this case, the Applicant submits that the Examiner has merely made conclusory findings regarding the motivation to modify the cited references, and requests the Examiner to withdraw his rejection upon the basis of these references.

Claims 2-5, 8, 15, 16, 20, 21, 23, 24, 26-32, and 38-40

Since Claims 2-5, 8, 15, 16, 20, 21, 23, 24, 26-32, and 38-40 each depend on one of Claims 1, 14, 19, 22, 25, and 33, Applicant respectfully submits that these claims are allowable for the reasons discussed above and the subject matter of their own limitations.

Conclusion

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 7/30/2004

By: 

Eric M. Nelson
Registration No. 43,829
Attorney of Record
Customer No. 20,995
(619) 235-8550